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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,663	04/05/2001	Joseph Herbert McIntyre	AUS920010294US1	3501

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EXAMINER

AGDEPPA, HECTOR A

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 03/25/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,663

Applicant(s)

MCINTYRE, JOSEPH HERBERT

Examiner

Hector A. Agdeppa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 – 35 are provisionally rejected under the judicially created doctrine of double patenting over claims 1 - 31 of copending Application No. 09/826,666. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Both applications claim a method and system of call forwarding wherein a call may be transferred from a first telephone number to a second telephone number dependent upon a choice or preference made by a user receiving the incoming calls. Furthermore, both applications claim the same embodiments, i.e., wireless devices,

paggers, computers, laptops, etc. Finally, both applications claim the same configuration/component makeup in the claimed apparatuses.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 – 6, 10 – 14, 18 – 23, 27, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,160,877 (Tatchell et al.)

As to claims 1 – 3 and 18 - 20, Tatchell et al. teaches a personal agent system which allows for the selective forwarding of calls received at, for example, a subscriber's office number, read as the claimed first number, to the subscriber's home number, read as the claimed second number. Forwarding only occurs if the incoming call is one of a predetermined calling parties, read as the claimed selected incoming telephone calls. All other incoming calling parties or those part of a different predetermined group are

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routed to another number, a voice mail system, or some other default termination.

(Abstract, Col. 3, line 24 – Col. 5, line 2, Col. 9, line 29 – Col. 12, line 19, Col. 18, line 55 – Col. 22, line 33)

As to claims 4 and 21, personal agent 11 is basically a processor that can either be co-located with a telephone switching center 10, or located on its own. Moreover, it contains at least an application processor 21 and various databases 22. (Figs. 1 and 2a) As such, personal agent 11 is analogous to the claimed server.

As to claims 5 and 22, Tatchell et al. teaches that a subscriber of the personal agent can access the personal agent and perform any and all function available therefrom, including provisioning the subscriber's databases wherein the selected callers/numbers are identified, from any device, remote or local. (Col. 3, lines 60 – 63, Col. 7, lines 15 – 32, Col. 8, line 5 – Col. 9, line 28)

As to claims 6 and 23, see Col. 12, line 67 – Col. 13, line 29. Also see the rejection of claims 4 and 21, wherein it is taught that such information is stored in the personal agent's databases. Therefore, it is inherent that the selected information would have to be sent to personal agent/ server 11, since a subscriber will always access the personal agent only over a telephony device.

As to claims 10, 11, 27, and 28, see Col. 12, lines 58 – 66, Col. 13, line 38 – Col. 16, line 47. Because Tatchell et al. teaches that a subscriber may categorize contact numbers in their database, such reads on selecting numbers from the entire database, as well as "designating" them.

As to claims 12 and 14, Tatchell et al. teaches that the personal agent may be accessed/utilized from any telephony device such as a mobile phone, i.e., a wireless device/cellular phone. (Col. 7, lines 1 – 4)

As to claim 13, see Col. 7, lines 10 – 14 wherein Tatchell et al. teaches that either voice, or DTMF codes entered on the user device may be used to control, access, provision personal agent 11.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 7 – 9, 24 – 26, 13, 15 – 17, 29, 31, and 33 – 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,160,877 (Tatchell et al.)

As to claims 7 – 9 and 24 – 26 Tatchell et al. does not teach the use of a visual display for menus when interacting with personal agent 11. Tatchell et al. instead, teaches using voice recognition as the mode of interaction between the system and subscriber.

However, such is old and well known and it would have been obvious for one of ordinary skill in the art to have implemented visual displays in the invention of Tatchell et al. inasmuch as such a feature is merely a design choice or preference which is based on user functionality not having patentable relevance to the invention feature of

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the present invention, selective call forwarding. One motivation for having visual menus and interaction is because long lists of messages or intricate menus, for example, could be tedious and confusing to navigate via telephone key buttons or via voice. Therefore, certain inventions have chosen to use visual menu displays. On the other hand, visual displays also present a old and well known problem, especially in the mobile telephony arts, in that when driving a car, for example, having to look at and navigate a menu visually is quite dangerous. In such a scenario, audio interaction, such as voice recognition means, are a much safer way to interact with a device/system. As such, again, it is merely a design choice.

As to claim 29, see the rejection of claims 1, 4, 18 and 21. Furthermore, personal agent 11 has therein, at least, a processor 21 and various databases which communicate with each other. Databases and processors are not the same type of elements, nor do they perform the same operations. As such, it is inherent that a network interface would have to be used to allow for those two different types of elements to interact.

What Tatchell et al. does not teach is the use of a system bus. However, system busses are extremely old and well known and merely allow different components of a system to be connected to a common link allowing for communication therebetween. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have implemented personal agent 11 of Tatchell et al. in manner that utilized a system bus. The functionality and operation of personal agent 11 would not be affected by the use of a system bus as opposed to separate connections

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between the databases 22 and the processor 21. Moreover, Tatchell et al. does not even describe the type of connections used in personal agent 11. It could very well be that a system but is used.

As to claims 15 – 17 and 33 – 35, Tatchell et al. does not teach using a pager or computer/laptop to access personal agent 11. However, in modern telecommunications systems, the integration of various types of telephony and computer devices is very old and well known. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have contemplated using other devices besides strictly telephony devices to interact with personal agent 11. Tatchell et al. as discussed above, already contemplates using both landline and wireless telephones as well as receiving data and fax communications in addition to just voice communications. (Col.4 , line 34 and Col. 14, line 34, Col. 19, line 34)

As to claims 30 and 32, see the rejection of claims 12 and 14.

As to claim 31, see the rejection of claim 13.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 4,277,649 (Sheinbein) contemplates selective call forwarding in a method and apparatus for screening telephone calls. US 5,168,517 (Waldman) teaches an apparatus and method for selectively forwarding telephone calls. US 5,509,062 (Carlsen) teaches Intelligent terminal based selective call forwarding. US 5,583,564 (Rao et al) teaches intelligent call forwarding with videophone display of

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forwarding destination. US 6,125,126 (Hallenstal) teaches a method and apparatus for selective call forwarding. US 6,324,271 (Sawyer et al.) teaches a system and method for authentication of caller identification that may work in conjunction with selective call acceptance and forwarding. US 2002/0126827 (Pelletier et al.) teaches providing telephone services to remote subscribers including selective call forwarding.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector A. Agdeppa whose telephone number is 703-305-1844. The examiner can normally be reached on Mon thru Fri 9:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.A.A.
March 7, 2004


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